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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/368,045 08/03/99 MCDONALD

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EXAMINER

KYLE, C

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

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*[Handwritten mark]*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

*[Handwritten signature]*

# Office Action Summary

Application No.

09/368,045

Applicant(s)

MCDONALD ET AL.

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 August 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 8, 77, 79, 80 and 81 are rejected under the second paragraph of 35 U.S.C. 112.

Claim 7 recites the limitation "the retail system application" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 is rejected as depending from Claim 7.

Claim 77 recites the limitation "the retail banking application" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 79 recites the limitation "the method of" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 80 recites the limitation "the method of" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 81 recites the limitation "the method of" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The Claims above have been examined with respect to relevant art to the best of the Examiner's ability, given the lack of clarity.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Transue et al in view of Lawlor et al.

As to Claim 1, Transue et al disclose the invention substantially as claimed, including bill payment for a customer (col. 1, line 5 to col. 3, line 40) comprising: receiving information about at least one bill payment for a customer (Figure 4, elements 404, 408, and 412 and col. 11, line 32 to col. 12, line 5);

automatically scheduling the bill payment for the customer according to the bill payment information (Fig. 4, element 420 and col. 12, lines 31-37);

Transue et al do not specifically discuss the details of rendering the scheduled bill payment to a payee for the customer, although the function is implicit in the title. See also col. 15, line 63 to col. 16, line 10. Lawlor et al disclose such detailed rendering at col. 33, line 3 to col. 34, line 45 and col. 43, line 48 to col. 46, line 57. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the detailed payment rendering functions disclosed by Lawlor et al in the bill payment invention of Transue et al because this would have made possible the performance of standard bill payment and reconciliation functions as are necessary in institutional and personal finance.

Concerning Claim 2, Transue et al disclose receiving a request for bill payment service for the customer at Fig. 1 and col. 3, line 66 to col. 4, line 20.

As to Claims 3 and 4, Transue et al disclose receiving identification information for the customer and automatic verification of identification information by a retail system application at col. 2, lines 22-36.

Regarding Claim 5, Transue et al disclose receiving selection for the bill payment service for the customer at col. 4, lines 7-20.

Concerning Claim 6, Transue et al disclose an automatic prompt for the customer for selection of bill payment service at Fig. 1, "Main Menu – To Make a Payment".

As to Claim 7, Transue et al disclose automatic handoff of the customer by the retail system application to a bill payment application at col. 15, line 63 to col. 16, line 10.

Regarding Claim 8, see the discussion of Claim 7 and it would further have been obvious to have handed off identification information for the customer because this would have spared the customer from reentering identification data and would thus have increased customer satisfaction.

Concerning Claim 9, see the discussion of Claim 3.

As to Claim 10, see the discussion of Claim 4.

Regarding Claim 11, Transue et al disclose selection of one of a touch tone mode and a voice mode of entering bill payment information for the customer at col. 3, line 66 to col. 4, line 40.

Concerning Claim 12, Transue et al disclose an automatic prompt of the customer by the bill payment application for the selection of a mode at Fig 1., "Press 1 or Say" item.

As to Claims 13-16, see the discussion of Claims 11 and 12 above.

Regarding Claim 17, Transue et al disclose election for a recurring bill payment option at Fig. 4, element 402, for an add or change payee option at Fig. 3A, elements 316 and 328, for a single bill payment option at Fig. 4, element 402 and for a status, change or cancel bill payment option at Fig. 5, element 500. Also, see related text.

Concerning Claim 18, Transue et al disclose receiving an election for a recurring bill payment option at Fig. 4, right hand side of figure and col. 11, line 32 to col. 13, line 65.

As to Claim 19, Transue et al disclose in a recurring payment process, a customer option to return to Main Menu at Fig. 4, element 418; the Main Menu (Fig 1) provides the customer with an option to speak with a Customer Service Representative. It would have been obvious to have further provided the Representative with the capacity to process a recurring bill payment for customers not wishing to do so, as this would have minimized customer dissatisfaction with the process.

Regarding Claim 20, Transue et al disclose receiving an election for an add or change payee for bill payment option at Fig. 3A, inputs 2 and 3 respectively and at col. 4, line 41 to col. 5, line 36.

Concerning Claim 21, Transue et al disclose automatic handoff of the customer to change a payee at col. 15, line 63 to col. 16, line 10 and Fig. 2, "Merchant Maintenance", element "To Speak with a Customer Service Representative".

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As to Claim 22, Transue et al disclose receiving an election for a single bill payment option at Fig. 4, left hand side of figure and at col. 11, line 32 to col. 13, line 65.

Regarding Claim 23, Transue et al disclose receiving an election for a status, change or cancel bill payment option at Fig. 5, element 500 and col. 14, line 2, to col. 15, line 46.

Concerning Claims 24 and 25, Transue et al disclose automatically prompting for and receiving a selection for a single bill payment option for the customer at Fig. 4, left hand side of figure and col. 11, lines 32-49.

As to Claims 26 and 27, Transue et al disclose automatically prompting for and receiving information about a payee at col. 11, lines 38-47.

Regarding Claims 28 and 29, Transue et al disclose automatically prompting for and receiving payee information from the payee ID list of the customer at col. 11, lines 38-49.

Concerning Claim 30, Lawlor et al disclose receiving an ID number for the payee at col. 33, lines 12-19. It would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized an ID number as taught by Lawlor et al in the bill payment method disclosed by Transue et al because this would have avoided ambiguity and confusion in the identification of a particular payee. Further, Transue et al disclose the use of a payee ID number at col. 2, lines 22-36, thus suggesting the combination of the two references.

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As to Claim 31, Transue et al disclose automatic identification of fields of information within the bill payment application at col. 6, line 63 to col. col. 7, line 22 and col. 16, lines 11-26. As other fields in their system are automatically identified, it would have been obvious to have so identified the payee according to an ID number because this would have provided seamless operation in the bill paying process.

Regarding Claims 32 and 33, Transue et al does not specifically disclose receiving a selection for the customer to enter information according to a payee list spoken for the customer and receiving a selection from the payee list. Lawlor et al disclose receiving a selection for the customer to enter information according to a payee list (col. 42, lines 60-62) and receiving a selection form the payee list (col. 42, line 60 to col. 43, line 68). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included these features of Transue et al in the voice mode method of Transue et al because this would have provided an uniform and efficient way for customers to have selected payees.

Concerning Claims 34 and 35, see the discussion of Claim 31.

As to Claim 36, Transue et al disclose automatically verifying a scheduled bill payment by receiving a confirmation of a payee at col. 11, lines 50-58.

As to Claims 37 and 38, Transue et al disclose automatically prompting for and receiving a payment amount for a bill payment at col. 11, lines 54-61.

Regarding Claims 39 and 40, Transue et al disclose automatically prompting for and receiving a payment date for a bill payment at col. 12, lines 6-9.



Concerning Claim 41, 42 and 43, Transue et al disclose automatically verifying a scheduled bill payment by receiving a confirmation of at least one of a payee, a payment amount and a payment date in response to an automatic prompt at col. 11, lines 50-58, col. 12, lines 1-5 and col. 12, lines 13-18.

As to Claim 44, Lawlor et al disclose assignment of a payment reference for a scheduled bill payment at col. 34, lines 1-4.

Concerning Claim 45, Lawlor et al disclose the use of the reference for service purposes for the user/customer. To provide such service, it would have been obvious to have provided such a reference to the customer in the method of Transue et al so that he or she would have a unique and simple means to identify the payment in discussions with bill payment service representatives.

Regarding Claims 46 and 47, Transue et al disclose automatically prompting for and selection of a hearing a list of bill payments at col. 14, lines 20-30 and Fig 15, element 504.

Concerning Claim 48, Transue et al disclose automatically speaking a list of bill payments at col. 14, lines 8-11.

As to Claim 49, Lawlor et al disclose rendering a scheduled payment in an amount indicated by the customer to a payee identified by the customer on a date designated by the customer at col. 43, line 48 to col. 45, line 48.

Regarding Claim 50, Lawlor et al disclose payment by check at col. 11, lines 55-60 and col. 33, line 63 to col. 34, line 1.

As to Claim 51, Lawlor et al disclose combining of more than one bill in a payment at col. 11, lines 55-60.

Concerning Claim 52, Lawlor et al disclose electronic transfer of funds at col. 11, lines 55-60.

Regarding Claims 53 and 54, Transue et al disclose automatically prompting for and receiving a selection of status, change or cancel option for bill payments at Figure 5 and col. 14, line 3 to col. 15, line 45; particularly col. 14, lines 3-5 and col. 14, lines 8, 31 and 64.

Concerning Claims 55 and 56, Transue et al disclose automatically prompting for (col. 14, lines 3-5) and receiving a selection of status of a future bill payment (col. 14, lines 20-23).

As to Claim 57, Transue et al disclose receiving a selection by the customer for the status of future bill payments at col. 14, lines 8-30.

Regarding Claim 58, Transue et al disclose the selection for the customer of status of all future bill payments at col. 11, lines 3-5 and 20-30.

Concerning Claim 59, Transue et al do not specifically disclose receiving a selection for the status of all open bill payments for the customer. Lawlor et al suggest such a selection at col. 14, lines 3-6 and col. 20, lines 44-53 in discussions of reconciliation. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a selection for display of all open bill payments because this would have made possible such reconciliation. For example, with status information for open bill payments and all bill payments, the customer would have been

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able to balance his or her checkbook; open bill payments represent "uncleared" checks, which information is essential to reconciliation.

Concerning Claim 60, Transue et al disclose automatically speaking a list of bill payments at col. 14, lines 8-11. It would have been obvious to have spoken the status of open bill payments because this would have facilitated the reconciliation suggested by Lawlor et al disclose and discussed regarding Claim 59.

As to Claims 61, Transue et al disclose receiving a selection by the customer for the status of future bill payments at col. 14, lines 8-30.

Regarding Claim 62 see the discussions of Claim 59 and 60 above.

As to Claim 63, Transue et al disclose change of all bill payments at col. 14, line 64 to col. 15, line 46.

Regarding Claim 64, Transue et al disclose receiving of a selection of single or recurring bill payments at Fig.4, element 402. Further, they teach change operations for bills processed by the system at col. 14, line 64 to col. 15, line 46.

Concerning Claims 65 and 66, see the discussion of Claim 64 above and Transue et al further teach automatic prompting of customers for bill payment change information at col. 14, lines 3-5.

As to Claims 67, see the discussion of Claim 64 above.

Regarding Claim 68, Transue et al disclose automatic handing off of the customer to a customer service representative at col. 15, lines 47-62 and Fig. 1, "To Speak with a Customer Service Representative" element.

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As to Claim 69, Transue et al disclose cancellation of all bill payments at col. 14, lines 31-63.

Regarding Claim 70, Transue et al disclose receiving of a selection of single or recurring bill payments at Fig. 4, element 402. Further, they teach cancellation operations for bills processed by the system at col. 14, lines 31-63.

Concerning Claims 71 and 72, see the discussion of Claims 70 above and Transue et al further teach automatic prompting of customers for bill payment cancellation information at col. 14, lines 3-5.

As to Claim 73, see the discussion of Claim 70 above.

Regarding Claim 74, Transue et al disclose automatic handing off of the customer to a customer service representative at col. 15, lines 47-62 and Fig. 1, "To Speak with a Customer Service Representative" element.

Concerning Claim 75, Transue et al disclose the invention substantially as claimed, including a system for bill payment service for a customer (See Abstract and Summary of the Invention) comprising:

a means for receiving information about at least one bill payment for a customer (Figure 4, elements 404, 408, and 412 and col. 11, line 32 to col. 12, line 5);

means associated with the receiving means for automatically scheduling the bill payment for the customer according to the bill payment information (Fig. 4, element 420 and col. 12, lines 31-37);

Transue et al do not specifically discuss the system details of rendering the scheduled bill payment to a payee for the customer, although this is implicit in the title.

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See also col. 15, line 63 to col. 16, line 10. Lawlor et al disclose such detailed rendering means at col. 33, line 3 to col. 34, line 45 and col. 43, line 48 to col. 46, line 57. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the detailed payment rendering system disclosed by Lawlor et al in the bill payment system of Transue et al because this would have enabled the system to perform standard bill payment and reconciliation functions as are necessary in institutional and personal finance.

As to Claim 76, Lawlor et al disclose a bill payment application running on a server at Figure 1, element 52, and col. 19, lines 37-53.

As to Claim 77, Transue et al disclose a retail system application communicating with a bill payment application at col. 15, line 63 to col. 16, line 10.

Concerning Claims 78 and 79, Transue et al disclose an input device as a telephone at col. 4, lines 2-40.

As to Claim 80, Transue et al disclose automatically scheduling for bill payment for the customer according to the bill payment information (Fig. 4, element 420 and col. 12, lines 31-37); Lawlor et al disclose scheduling means comprising a bill payment application running on a server at col. 47, lines 19-59. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the bill payment application running on a server taught by Lawlor et al to automatically schedule bill payments as taught by Transue et al because the problem addressed by Transue et al is solved by Lawlor et al.

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As to Claim 81, Lawlor et al disclose a bill payment rendering means comprising a bill payment application running on a server at col. 33, line 51 to col. 34, line 4.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on Monday - Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

crk

crk

May 9, 2001

*Robert W. Downs*

**ROBERT W. DOWNS  
PRIMARY EXAMINER**